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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/698,010	10/30/2003	Michael E. Landry	5259-10700US02	7409
23492	7590	02/06/2008		
ROBERT DEBERARDINE ABBOTT LABORATORIES 100 ABBOTT PARK ROAD DEPT. 377/AP6A ABBOTT PARK, IL 60064-6008			EXAMINER SWIGER III, JAMES L	
			ART UNIT 3733	PAPER NUMBER
			NOTIFICATION DATE 02/06/2008	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

Patents_Abbott_Park@abbott.com
Legal_Patents@abbott.com

Office Action Summary	Application No.		Applicant(s)	
	10/698,010		LANDRY ET AL.	
	Examiner		Art Unit	
	James L. Swiger		3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 123-192 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 123-192 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 October 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/29/2007; 10/30/2007</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 10/29/2007 has been entered.

Information Disclosure Statement

It is noted that the IDS forms submitted on 10/29/2007 and 10/30/2007 contain identical references. Despite the letter titled "Miscellaneous Action with SSP" dated 11/2/2007, the submitted References have been considered. A copy of the considered IDS is attached herewith.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 123, 142, and 159 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 123, 141, and 159 of copending Application No. 11/752,167. Although the conflicting claims are not identical, they are not patentably distinct from each other because each claims similar subject matter including a first and second bone screws, a collar, a rod and sleeve, wherein the sleeve coupling system to attach to the collar is substantially similar, and a closure member.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 123-135, 141-152, 159-172, and 178-192 rejected under 35 U.S.C. 103(a) as being unpatentable over Biedermann et al. (US Patent 5,443,467) in view of Boehm, Jr. et al. (US Publication 2004/0039384). Biedermann et al. disclose a first bone

screw (1) configured to be screwed into vertebra, a first collar (5) that is rotatably coupled to the first bone screw (see fig. 2) and has a slot, a rod (16) with a width necessary to fit into the slot, a first sleeve (14) comprising a channel (down through it) that extends through, a first closure member (13) configured to be secured to the collar, and further wherein the collar and sleeve are configured to detachably couple (they may be attached via a threaded attachment).

Biedermann et al. discloses the claimed invention except for having a sleeve that is longer than the length of the bone screw or wherein a channel specifically is formed in a wall of the sleeve. It is noted that in the sleeve of Biedermann et al. the end is not considered a wall, but if considered an opening, allows the rod to be inserted through this sleeve portion into the channel of the bone screw and collar.

Boehm, Jr. et al. disclose a sleeve that is longer than the length of a bone screw (see Fig. 11) that has a channel/opening in the side of the sleeve that extends along at least a portion of the sleeve and wherein the sleeve aligns with a slot in the collar or bone screw (see fig. 12, and also paragraph 0057). It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of Biedermann et al. having the sleeve configuration of Boehm, Jr. et al. to better perform percutaneous surgery and align the screw and rod assembly in an efficient and accurate manner.

Further, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the assembly of the combination of Biedermann et al. and Boehm, Jr et al. having multiple sleeves, bone screws, and

collars, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Claims 136-140, 154-158, and 173-177 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Biedermann et al. and Boehm, Jr. et al. as applied to claims 123, 1442, and 159, respectively above, and further in view of Le Couedic et al. (US Patent 6,090,113). The combination of Biedermann and Boehm, Jr. et al. disclose the claimed apparatus except for a frame to hold the sleeves together to achieve distraction, translation, or compression in use of the devices. Le Couedic et al. discloses a frame assembly (31) that allows for precise adjustment of the spinal device and arranging the pedicle screws for insertion (Col. 2, lines 10-30). It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of the combination of Biedermann et al. and Boehm, Jr. et al. and further in view of Le Couedic et al. having a frame assembly, to more accurately insert the screws into the vertebrae.

Response to Arguments

The previous allowability of the claims in the action dated 10/12/2007 has been withdrawn in view of the above rejections.

The IDS as disclosed above, have been considered.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to James L. Swiger whose telephone number is 571-272-5557. The examiner can normally be reached on Monday through Friday, 9:00am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



JLS

1/29/2006

